

REMARKS

The following remarks are responsive to the October 17, 2008, Non-Final Office Action.

At the time of the Office Action, claims 1–13 were pending. The status of the claims is as follows:

- Claims 1–13 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite;
- Claim 13 stands rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement;
- Claims 1 and 6–13 stand rejected under 35 U.S.C. §102(e) as being anticipated by Zabawshyj (U.S. Patent Publication No. 2004/0038688);
- Claims 2, 4, and 5 stand rejected under U.S.C. §103(a) as being obvious over Zabawshyj in view of Caspi (U.S. Patent Publication No. 2005/0079873); and
- Claim 3 stands rejected under U.S.C. §103(a) as being obvious over Zabawshyj in view of Caspi and Qu (U.S. Patent Publication No. 2003/0083079).

35 U.S.C. §112, Second Paragraph, Indefiniteness of Claims 1–13

1. Applicants have amended independent claims 1 and 10 to clarify that the first signal does not originate from the first subscriber.

In the Office Action, on pp. 2–3, the Examiner rejected claims 1–13 as being indefinite because it appeared from the claim language that the sender and recipient of the first message was the same entity.

Independent claims 1 and 10 have been amended to indicate that the sending of the first signal is distinctive of the mobile subscriber. In other words, these claims have been amended to clarify that the mobile subscriber is not necessarily the originator of the first signal—this signal could originate from any potential entity, and what is relevant is not the origin of the signal, but that the signal is intended for a particular mobile subscriber.

Based on these amendments and the clarifying remarks, Applicant asserts that this language is sufficiently definite and requests that the Examiner withdraw the 35 U.S.C. §112,

In re Appln. of Anza Hormigo et al.
Application No. 10/564,949
Response to Office Action of October 17, 2008

second paragraph, rejection from the application.

35 U.S.C. §112, First Paragraph, Enablement of Claim 13

2. Applicants have canceled claim 13.

On p. 3 of the Office Action, the Examiner rejected claim 13 as not being enabled by the Specification. Applicants have accordingly canceled claim 13 and request that this rejection be withdrawn from the Application.

35 U.S.C. §102(e) Anticipation of Claims 1 and 6–13 by Zabawshyj

3. Applicants have amended independent claims 1 and 10 to include certain limitations of claim 2, namely that a second transition is enabled by the expiration of a time delay without a reaction from the network.

In the Office Action, on pp. 4–6, the Examiner rejected claims 1 and 6–13 as being anticipated by Zabawshyj, indicating how the teaching of Zabawshyj was being read on elements of claim 1.

Claims 1 and 10 have been amended in order to provide that the step for determining a present or not present state is activated based on transitions enabled by a reaction or an absence of a reaction of the network within a period of time .

Zabawshyj discloses a method for informing an application server whether or not a subscriber is present on a network. For that purpose, a Short Message Service (SMS) message is sent to a mobile subscriber in order to determine a present status of this subscriber on the basis of the network response to this SMS.

However, Zabawshyj does not teach or suggest that this method allows one to determine a “non present” state based on a “non reaction” of the network during a determined time period, as is indicated by the Examiner on p. 6 of the Office Action.

Based on the amendment to claims 1 and 10, Applicants assert that these claims, as well as the claims that depend therefrom are not anticipated by Zabawshyj and respectfully request that the 35 U.S.C. §102 rejection be withdrawn from the application. The question of

obviousness of the amended claims 1 and 10 are addressed in more detail below.

35 U.S.C. §103(a) Obviousness of Claims 2, 4, and 5 by Zabawshyj in view of Caspi

4. Applicants have amended independent claims 1 and 10 to include certain limitations of claim 2, namely that a second transition is enabled by the expiration of a time delay without a reaction from the network. The combination of Zabawshyj and Caspi does not teach or suggest independent claim 1 as amended because Caspi's watchdog timer is not used to determine if the subscriber is present or not on the network.

In the Office Action, on pp. 6–7, the Examiner rejected claims 2, 4, and 5 as being obviated by the combination of Zabawshyj and Caspi, and indicated how the teaching of this combination was being read on elements of claim 2, of which certain elements have been incorporated into claim 1.

The Examiner indicated:

Zabawshyj does not explicitly teach a second transition enabled by an expiry of a time delay without reaction from the mobile telecommunication network, activates the second step that determines the present, respectively not present state of the mobile subscriber. Caspi discloses a system and method for centrally hosted presence reporting (title). Caspi teaches a second transition enabled by an expiry of a time delay without reaction from the mobile telecommunication network, activates the second step that determines the present, respectively not present state of the mobile subscriber (paragraph 134).

Applicants respectfully disagree with this characterization of the teaching of Caspi. Caspi discloses a method for detection of presence in an Instant Messaging System. In this type of system, a present status of users is determined and dispatched to the other users in the system. For that purpose, localization information of the subscriber is taken into account to complete the information already available. Such localization information can be provided by a Global Positioning System (GPS).

Moreover, Caspi discloses that a watchdog timer is used in order to determine if a subscriber terminal is operational (paragraph [0131]). Thus, an interrogating message, which is a simple message, is sent to the terminal, and a timer is started. If the timer expires before reception of a response from the terminal, the terminal is considered as “unavailable” or “unknown” (paragraphs [0131] to [0134]).

Clearly, this watchdog timer is used in order to determine if the terminal is operational, but it is not used to determine if the subscriber is present or not on the network. Consequently, claim 1 requires that a timer is be used differently than it is used according to Caspi. Caspi's interrogating message is a signal of type "Here I am" and it is not an SMS message. Moreover, when no response is received during a time period, the terminal is considered as "unavailable" or "unknown", but no determination is done regarding its presence or not on the network, as is required by claim 1.

In case of combination of Zabawshyj and Caspi, a person skilled in the art would, in the best case, obtain a system adapted to determine a present state for a terminal based on SMS, and adapted to determine an operational state for the terminal based on a simple message "here I am". But, the person skilled in the art would not obtain the subject matter of amended claim 1 based on this combination of references.

35 U.S.C. §103(a) Obviousness of Claim 3 over Zabawshyj in view of Caspi and Qu

5. Applicant relies upon the above arguments with respect to dependent claim 3, and asserts that the addition of Qu does not supplant the deficiencies identified above with respect to the Zabawshyj and Caspi.

In the Office Action, on pp. 7–8, the Examiner combined Zabawshyj and Caspi with Qu in establishing an obviating combination of references for claim 3. Without addressing the specifics of the additional reference on the merits, Applicants rely upon the above arguments and asserts that the disclosure of Qu, alone or in combination, does not serve to solve the deficiencies of the teachings of Zabawshyj and Caspi. The Examiner has cited this reference for purposes related to the specifics of claim 3.

For these reasons, the Applicant asserts that the claim language clearly distinguishes over the prior art, and respectfully request that the Examiner withdraw the §103 rejection from the present application.

In re Appln. of Anza Hormigo et al.
Application No. 10/564,949
Response to Office Action of October 17, 2008

CONCLUSION

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

/brian c. rupp/

Brian C. Rupp, Reg. No. 35,665
Mark Bergner, Reg. No. 45,877
DRINKER BIDDLE & REATH LLP
191 N. Wacker Drive, Suite 3700
Chicago, Illinois 60606-1698
(312) 569-1000 (telephone)
(312) 569-3000 (facsimile)
Customer No.: 08968

Date: February 17, 2009
CH01/ 25302915.1